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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,238	02/07/2000	Gregory A. Stobbs		9957

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Harness, Dickey & Pierce. P.L.C.
P. O. Box 828
Bloomfield Hills, MI 48303

EXAMINER

WONG, LESLIE

ART UNIT PAPER NUMBER

2164

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/499,238	Applicant(s) STOBBS ET AL.	
	Examiner Leslie Wong	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,11-22,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,11-22,31, and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-7, 11-13, 15-17, 20-22 and 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by **Barney et al.** ("Barney") (US 6556992 B1).

Regarding claims 1, 11, and 32, **Barney** teaches a method and computer implemented patent portfolio analysis method comprising:

- a). retrieving a corpus of patent information from a database, said information including multiple claims from a plurality of patent documents (col. 12, lines 23-32; col. 11, lines 38-59);
- b). automatically determining claim breadth metrics for the multiple claims (col. 24, lines 17-31; col. 12, lines 14-18 and 54-56);
- c). associating said claim breadth metric with said claim text and storing said associated metric in a computer-readable dataset (col. 26, lines 1-15 and Table 4); and

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d). wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is (col. 12, lines 14-18, col. 19, lines 53-64 and Fig. 11).

Regarding claims 2 and 12, **Barney** further teaches a step of analyzing the claim text includes counting the number of words in said claim text (col. 20, lines 18-26).

Regarding claims 3 and 13, **Barney** further teaches a step wherein said step of analyzing the claim text includes identifying within said claim text a preamble portion and a body portion, counting the number of words in said preamble and body portions and applying separate weights to said count to generate said claim breadth metric (col. 20, lines 29-41).

Regarding claims 5 and 15, **Barney** further teaches a step of displaying said patent information in a sorted order based on claim breadth metric (Fig. 11).

Regarding claim 6, **Barney** further teaches a step of analyzing the claim text includes linguistically processing said text to identify at least one clause within said claim text that has a lower probability than other of said clauses within said claim text of being found in other claims within said corpus (col. 25, lines 13-23).

Regarding claim 7, **Barney** further teaches a step of displaying said claim text such that said one clause is visually presented differently than the other of said clauses (Fig. 11).

Regarding claim 16, **Barney** further teaches a step wherein the sorted patent documents are used in a patent infringement study (col. 20, lines 18-25 and Fig. 4).

Regarding claim 17, **Barney** further teaches a step wherein the sorted patent documents are used to determine patent documents whose maintenance fees are not to be paid (col. 13, lines 59-66).

Regarding claims 20-22, **Barney** further teaches a step wherein generating descriptive statistics based upon the generated claim breadth metrics, wherein the generated descriptive statistics are indicative of quality of claims (col. 20, lines 18-25).

Regarding claim 31, **Barney** further teaches a computer-implemented patent portfolio analysis apparatus comprising:

- a). a database of patent documents containing text of claims (col. 12, lines 23-32; col. 11, lines 38-59);
- b). a claim breadth analysis module that analyzes the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim, wherein the claim breadth metrics are provided

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over an internet network for use in analyzing scope of the claims (col. 24, lines 17-31; col. 12, lines 14-18 and 54-56 and Fig. 11);

c). a cluster generator that analyzes patent information to generate category metrics for the patent documents, wherein clusters of patent documents are determined based upon the generated category metrics, wherein the clusters of patent documents are provided over an internet network for use in analyzing the patent documents (col. 26, lines 1-15; col. 28, lines 13-25 and Table 4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 4, 14, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Barney et al. ("Barney ")** (U.S. Patent 6,038,561) as applied to claims 1-3, 5-7, 11-13, 15-17, 20-22 and 31-32 above in view **Snyder et al. ("Snyder")** (US 6038561 A).

Regarding claim 4, 14, and 18, **Barney** further teaches comparing using said clauses with the text of other claims in said corpus to generate scores indicative of which clauses within said claim text have a lower probability of being found in other claims within said corpus (col. 9, lines 28-44).

Barney does not explicitly teach analyzing claim text includes parsing said text to identify parts of speech, using said identified parts of speech to identify clauses within said claim.

Snyder, however, teaches analyzing claim text includes parsing said text to identify parts of speech, using said identified parts of speech to identify clauses within said claim (col. 13, lines 44-56 and 33-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Snyder's** teaching would have allowed **Barney's** to enable the system to rapidly access information about various documents and claims by preprocessed documents for subsequent analysis as suggested by **Snyder** at (col. 13, lines 55-56 and col. 13, lines 66 – col. 14, line 1).

Regarding claim 19, **Barney** further teaches a step of displaying said claim text such that said one clause is visually presented differently than the other of said clauses (Fig. 11).

Response to Argument

5. Applicants' arguments filed 22 December 2005 have been fully considered but they are not persuasive.

Applicants argue that Barney reference is not prior art because Applicants are entitled to a filing date of February 5, 1999.

In response to the preceding arguments, Examiner respectfully submits that a review of U.S. Provisional Application Serial No. 60/119210, filed 05 February 1999, indicates that the mentioned priority application does not support the claimed subject matter. The provisional application discloses the claim breadth analysis engine which examines the number of words of a claim in order to provide an indication of how broad a claim is; however, it is not seen that it teaches any subject matters related to claimed limitation "associating **claim breadth metric with claim text...**"

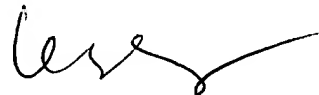
Therefore, Applicant is not entitled to the benefit of an earlier filing date of the U.S. Provisional Application Serial No. 60/119210. Hence, Barney remains prior art and thus the previous rejection dated 17 September 2005 is proper.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Leslie Wong
Primary Patent Examiner
Art Unit 2167

LW
March 22, 2006